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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,151

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Nick James Metcalfe

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EXAMINER

STROUD, JONATHAN R

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

01/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,151	Applicant(s) METCALFE ET AL.	
	Examiner JONATHAN STROUD	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 18-48 is/are pending in the application.
- 4a) Of the above claim(s) 37-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 18-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Remarks, filed 08/24/2009, have been fully considered and are not persuasive.
2. Applicant first argues that the prior art reference Martin does not disclose a "resilient" material as defined by applicants, and by one definition from the Random House dictionary. However, applicant is reminded that the broadest reasonable interpretation of the claims will be taken, not the one most favorable to the applicant's invention. The Merriam-Webster dictionary defines resilient as "capable of withstanding shock without permanent deformation or rupture." The material disclosed in Martin is capable of withstanding shock, strain or blows without permanent deformation or rupture under one reasonable interpretation. See MPEP 2111. Therefore, applicant's arguments are not persuasive.
3. Applicant second argues that the claim language "integrally formed" requires the feature be comprised of the same continuous component. The office respectfully disagrees. If elements 24a and 14 are part of separate components 12 and 22, that does not mean that those two components together cannot comprise a single "second portion" with elements "integrally formed with" the second portion. The two components 12 and 22 form one unitary piece, the "second portion," and those two pieces are "integrally formed" under a reasonable interpretation. However, even assuming *arguendo* that the two components together could not themselves be "integrally formed," which the office asserts is not true, the claim language merely requires that the

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resilient arm be integrally formed with the "second portion" in some way or manner.

Even with the most narrow definition of integral - that of being a single solid unitary, unbroken, or continuous piece, the claim language does not require the second portion itself to fit the definition, only that the resilient arm be connected in a single solid unitary or unbroken continuous way. Therefore, for at least the two reasons outlined above, applicant's arguments are unpersuasive.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 18-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin 6,656,225.

3. Re claims 1, 18, 19, 21, 24, 25 and 26, Martin teaches a device comprising a first portion 10 and a second portion 20 being releasably connected to each other by first and second formations (14 and 24 a, b), the first formation comprising a resilient arm 14, which is integrally formed, and the second portion 20 being at least partially bifurcated (24 a, b) the arm forming a fork of the bifurcated part.

4. Re claim 20, Martin teaches the first formation has a recess, 26, 24b.

5. Re claim 22, the recesses 26, 24b are formed on the resilient arm 14 and engage the first formation 20.

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6. Re claim 23, the recesses are formed at the free end of the resilient arm.
7. Re claim 27, The first portion has a first planar guide surface, inner surface of 26.
8. Re claim 28, Martin teaches abutments 16 a, b.
9. Re claim 29, Martin can be adapted to be connected to a plurality of alternative sections.
10. Re claim 30, first element 20 can be considered a surgical tool.
11. Re claim 31, first element 21 can include rasp, file or broach surfaces – further Martin teaches using broaches in the surgical procedure, which can be connected/comprise the first portion.
12. Re claim 32, the first formation comprises an annular ridge, 25b.
13. Re claim 33, the resilient arm is arcuate and curves partially around the circumference of the surgical tool.
14. Re claim 34, the second portion can be called a handle.
15. Re claim 35, the second portion comprises an adaptor.
16. Re claim 36, a plurality of adaptors of different geometries could be provided.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN STROUD whose telephone number is (571)270-3070. The examiner can normally be reached on 8-4, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jonathan R Stroud/
Examiner, Art Unit 3774

/William H. Matthews/
Primary Examiner, Art Unit 3774